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| 09/872,360      | 05/31/2001  | Gene H. Kan          | 5181-91401          | 1146             |

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EXAMINER

CHOULES, JACK M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2167

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/872,360

Applicant(s)

KAN ET AL.

Examiner

Jack M. Choules

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 29-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 29-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4 IDS's</u> . | 6) <input type="checkbox"/> Other: _____  |

IDS's 01/12/2004 03/26/2004 11/08/2004 and 11/10/2004

### **DETAILED ACTION**

1. Claims 1-12 and 29-69 are presented for examination. Claims 13-28 having been canceled and claim 6 amended. Note: claims 14-70 were renumbered as claims 13-69 in accordance with rule 1.126 as claim 13 was omitted and numbers cannot be skipped. Note: this application had been allowed and then an RCE was filled with new IDS's so the claims could receive full consideration in light of the newly presented art. Thus no arguments are on file.

#### ***Claim Rejections - 35 USC § 101***

2. Claims 47-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claim 47 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 84, lines 15-22, the medium of the instructions is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., storage media or memory media such as magnetic or optical media, e.g., disk or CD-ROM, volatile or non-volatile media such as RAM (e.g. SDRAM, DDR SDRAM, RDRAM, SRAM, etc.), ROM,) and intangible embodiments (e.g., as transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as network and/or a wireless link). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

4. Claims 48-57 are rejected for incorporating the errors of claim 47.

Art Unit: 2167

5. Therefore the examiner suggests a change in claim 47 to, instructions embodied on a storage media executable for, to limit to a tangible embodiment that is consistent with the specification.

### ***Double Patenting***

6. Claims 1-12, and 29-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/106,398, 10/106600, 10/106601, 10/106604, and 10/106731. Although the conflicting claims are not identical, they are not patentably distinct from each other because combinations of the claims from the parent have same elements for example the only element in claim 1 of the current application not in claim 1 of the previous application not included in claim 1 of the current application is the “common query protocol” which render the prior application to be narrower so claim 1 of the current subsumes claim 1 of the prior applications of the prior application. It is obvious to omit an element while losing the elements corresponding functionality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2167

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-7, 10-12, 33, 35-37, 40-43, 47, 50-54, 58-60, and 63-66 are rejected under 35

U.S.C. 102(B) as being anticipated by Syeda-Mahmood [hereinafter Syeda] Patent No. US 5,920,856 A. (This art was provided by the applicant in the IDS filed 10 November 2004.)

9. As to claims 1, 3-6, 10, 47, 50-53 and 58, Syeda taught an invention comprising “receiving a query request...” (figure 1, index 3, column 6 lines 49-53); “resolving the search query...” (figure 1, index 2; column 5, lines 39-65; column 6, lines 10-18 and lines 47-59); “routing the search query...” (figure 1, index 2; column 5, lines 39-65; column 6, lines 10-18 and lines 47-59); “receiving a query response...” (figure 1, index 1; figure 4; column 8, lines 13-56; column 6 lines 47-59); and “routing the search results...” (figure 1, index 1; figure 4; column 6, lines 30-46; column 8, lines 50-56; and column 9 lines 12-38).

10. As to claims 7, 11, 12, 40-43, 54, 59, and 63-66, Syeda taught collating search responses into an aggregate response ordered by relevance (column 6, lines 30-46). Response must inherently include some Query ID to be correlated.

11. As to claims 33, 35, 36, 37, and 60, Syeda taught text, video, and image, formats (figure 1, indexes 1 and 3).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 8, 31, 32, 34, 44, 55, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda as applied to claims 1, 10, 47, and 58 above.

14. As to claims 8, 44, 55, and 67, Syeda described providing “a definition of search queries” (column 5, lines 39-65; column 6, lines 10-18 and lines 47-59). However, Syeda does not detail including “an address” in the registration file. Providing an address such as a URL is well known in the database art to enable the system to access to data provider in a system such as the Internet in order to allow the system to find the provider when needed. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an address in the same file as the query definition to ensure that the address and definition information will be provide in a way that they will be stored and accessed together to simplify the process of retrieving the address and routing the query when it matches the stored query definition related to the address.

15. As to claims 31 and 32, Syeda does not teach a “deep search”, or a “wide search”, however, the examiner takes official notice that depth first, searches and breadth first searches are well known in the art and commonly used for deep searching and width searching.

16. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to provide depth first and breadth first algorithms as these are two well-known algorithms that provide though searching of a query space. Which one of the two is best is determined by the data structure and data distribution in the data source being searched at the time. So having a system that can use both algorithms is optimum.

17. As to claims 34, Syeda taught text, video, and image, formats (figure 1, indexes 1 and 3) however he did not specifically teach audio, it would have been at least obvious at the time of the

Art Unit: 2167

invention to one of ordinary skill in the art to allow for audio because audio if not included with video is another well known multimedia format that provides for greater flexibility in the data base system by providing storage and querying of a wider range of data types.

18. Claims 2, 9, 29, 30, 38, 39, 45, 46, 48, 49, 56, 57, 61, 62, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda as applied to claims 1, 8, 10, 11, 47, 56, 58, and 59 above, and further in view of Monday, US Patent No. 6,480,860 B1.

19. As to claims 2, 9, 29, 30, 38, 39, 45, 46, 48, 49, 56, 57, 61, 62, 68, and 69, Syeda does not detail “a markup language format [XML] for communicating query requests and query responses.” However, Monday describes a system with “a markup language format [XML] for communicating query requests and query responses.” (column 8, lines 29-68 and column 9, lines 1-37).

20. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Monday with Syeda because the use of XML for communicating queries in XML provides a user friendly GUI without manual updating of the software tool for each new data type in the system (column 1, lines 28-65) improving the versatility of the DP system.

***Allowable Subject Matter***

21. Claims 3-8, 12, 13, 18-19, 25, and 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



Art Unit: 2167

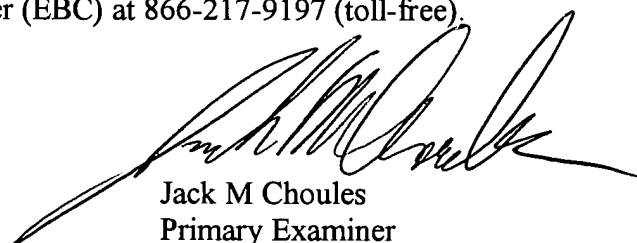
22. The applicants' arguments were found to be persuasive as directed the common query protocol addressed in reference to claim 1 relevant to claims 3-8 which depend on claim 1 and these claims and the prior art rejections. And Claims 18-19 are allowable as arguments directed to a ranking according to corresponding provider nodes were found to be convincing.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules  
Primary Examiner  
Art Unit 2167

9 August 2004